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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,592	07/21/2000	George Jackowski	3308.1001-000	5328

21005 7590 11/04/2003

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EXAMINER
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COOK, LISA V

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 11/04/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/621,592

Applicant(s)

JACKOWSKI, GEORGE

Examiner

Lisa V. Cook

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21,23-33 and 40-59 is/are pending in the application.
- 4a) Of the above claim(s) 40-43 and 46-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21, 23-33, 44-45, and 54-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Amendment Entry***

1. Applicants' response to the Office Action mailed 15 January 2003 (paper #24 filed 7/18/03) is acknowledged. In amendment-F filed therein claims 34, 60, and 61 were canceled without prejudice or disclaimer. While claims 21 and 54-59 were modified.
2. Currently, claims 21, 23-33, 44-45, and 54-59 are under examination

## **OBJECTIONS WITHDRAWN**

### ***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner on form PTO-892 or applicant on PTO-1449 has cited the references they have not been considered.

*Applicants have acknowledged that the listing of references in the specification is not proper and the consideration of the IDS filed 3/30/01. Accordingly the objection is withdrawn.*

## **OBJECTIONS MAINTAINED**

### ***Drawings***

4. The formal drawings filed 3/30/01 in this application has been objected to by the Draftsperson under 37 CFR 1.84 or 1.152 (see PTO-948). Applicant is required to submit a proposed drawing correction in reply to this Office action.

*Applicant has requested clarification regarding the drawings, which were reviewed by the Draftsperson on 12/6/01. The PTO-948 form cited the original filing date of the drawings (7/21/00). It is noted that the formal drawing were objected to as informal and as such were not formally presented with a PTO-948. The drawing which were reviewed and objected to by the Draftsperson in PTO-948 and attached to paper #14, were the formal drawings filed on March 30, 2001. Appropriate correction is required.*

#### REJECTIONS WITHDRAWN

##### ***Claim Rejections - 35 USC § 112***

5. Claims 21, 23-34, 44-45, and 54-59 stand withdrawn from rejection under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons of record on paper number 23.

6. Claims 21, 23-33, and 44-45 stand withdrawn from rejection under 35 U.S.C. 112, first paragraph, as being non-enabling for reasons of record on paper number 23.

*Applicant has addressed the rejection by arguments and amendments. Therein obviating the rejections. The rejections are withdrawn.*

REJECTION MAINTAINED

*Double Patenting*

7. Double patenting obviousness-type rejection:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 21 and 54-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of US patent 36,235,489.

Art Unit: 1641

Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are drawn to a method of analyzing the same four marker with respect to the distinction of a hemorrhagic cerebral event and an ischemic cerebral event.

This invention is encompassed within Patent # 6,235,489 wherein the same four markers are employed. In the Restriction Requirement in the parent application the analysis of all four markers was restricted from method detection only two of the markers.

Since the instant application is directed to "all four markers", it reads on the same inventive scope of patent #6,235,489.

***Response to Arguments***

*Applicant will file a Terminal Disclaimer and a Certificate under 37 CFR 3.73(b). The rejection is maintained until receipt and approval of the TD and Certificate.*

9. For reasons aforementioned, no claims are allowed.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 Fax number is (703) 872-9306, which is able to receive transmissions 24 hours/day, 7 days/week.

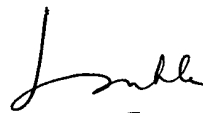
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa V. Cook whose telephone number is (703) 305-0808. The examiner can normally be reached on Monday-Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Lisa V. Cook  
Art Unit 1641  
CM1-7B17  
10/25/03



LONG V. LE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

10/31/03